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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.                 |
|--|-------------|----------------------|---------------------|----------------------------------|
| 10/612,211   | 07/02/2003  | Marc Van Damme       | 223328              | 5720                             |
| 23460  | 7590        | 09/03/2004           |                     |                                  |
| LEYDIG VOIT & MAYER, LTD<br>TWO PRUDENTIAL PLAZA, SUITE 4900<br>180 NORTH STETSON AVENUE<br>CHICAGO, IL 60601-6780 |             |                      |                     | EXAMINER<br>GILLIAM, BARBARA LEE |
|  |             |                      |                     | ART UNIT<br>1752 PAPER NUMBER    |

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/612,211             | VAN DAMME ET AL.    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Barbara L. Gilliam     | 1752                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 July 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 7/2/2003.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Urano et al. (US 2002/0058207 A1).

a. The image-forming material of Urano et al. meets the present limitations for the positive working lithographic printing plate precursor. Specifically the image-forming material of Urano et al. comprises a substrate, preferably an anodized and grained or electrolytically etched aluminum plate having a surface roughness of from 0.3 to 1.0  $\mu\text{m}$  ([0061]) and a positive photosensitive composition layer. The substrate of Urano et al. undergoes the same graining and anodization treatment prior to coating with the photosensitive layer. There is no express teaching however it is the Examiner's position the anodic oxide layer is inherently present on the surface of the aluminum substrate, as a result of the surface treatments. Additionally due to the over lap in the roughness taught by Urano et al. and presently claimed, the Examiner further asserts the amount of the anodic oxide layer is expected to at least overlap with the claimed range, absent any contrary evidence. MPEP 2112. *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The positive photosensitive composition layer contains a novolak resin and a photothermal conversion material (abstract; [0022]-[0041]). The novolak resin meets the present limitations for the hydrophobic polymer. The photosensitive layer is "heat-sensitive" due to the presence of the photothermal conversion material. The photosensitive layer further contains a solubility-suppressing agent that is considered to lower the solubility of the novolak resin in the alkali developer by forming a hydrogen bond with the novolak resin ([0048]-[0054]). The solubility-suppressing agent meets the present limitations for the water-repellent dissolution inhibitor. The composition can further contain various additives including a development-improving agent ([0056]) which meets the present limitations for the dissolution accelerator.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 2002/0094490 A1, Endo et al. teach a support for lithographic printing and a presensitized plate.

b. In US 2003/0031951 A1, Aburano et al. teach a photosensitive composition.

c. In US 2003/0232281 A1, Watanabe et al. teach a method for making lithographic printing plate.

d. In US 6,514,656 B1, Nakamura et al. teach a positive type image forming material.

e. In commonly assigned US 2003/0068578 A1, US 6,458,510 B1, US 6,455,229 B1, US 6,489,079 B1 the Ra value taught therein is outside the claimed range.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Barbara L. Gilliam*

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
September 1, 2004